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11/11

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,528	04/07/2004	David Sawyer	07844-648001	8330
21876	7590	04/04/2007		
FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER TANK, ANDREW L	
			ART UNIT	PAPER NUMBER
			2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/820,528	SAWYER, DAVID	
	Examiner	Art Unit	
	Andrew Tank	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the original filing of April 7, 2004. Claims 1-23 are pending and have been considered below.

Specification

2. The abstract of the disclosure is objected to because it seems that applicant has left off a portion of the abstract (Line 2-3 "A method includes"). Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because of the following informalities: page 4 line 4 includes a minor typographical error "graphical user inerface10".

Appropriate correction is required.

Claim Objections

4. Claims 13-23 are objected to because of the following informalities: minor typographical errors in the preamble. The claims recite: "A computer program product, tangible stored on..". The term "tangible stored" seems to be a typographical error and should read "tangibly stored". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 13-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a computer program product tangibly stored on a machine-readable storage device, does not reasonably provide enablement for a computer program product tangibly stored in a propagated signal. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. A propagated signal is a carrier medium and not a storage medium. One of ordinary skill in the art at the time the present invention was made would know that a computer program transmitted over a propagated signal must still reside in a storage medium before being machine-readable. Therefore, the disclosure does not provide enablement for how one of ordinary skill in the art would tangibly store a computer program in a propagated signal.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8, 9 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 8 and 19: Claims 8 and 9 recite the limitation of “a set of toolbar constraints” for both the source toolbar and the destination toolbar. In lines 11-12 of claim 8 and lines 13-14 of claim 9, “calculating a modified presentation of the source toolbar and the destination toolbar subject to the set of toolbar constraints;” This statement is indefinite as there are more than one set of toolbar constraints that could be applied.

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For the remainder of the present prosecution, the examiner will interpret this statement as reading the source toolbar and the destination toolbar are subject to their respective set of toolbar constraints.

- Claim 9: Claim 9 as in claim 8 above, recites "the toolbar constraints" in line 3.

Again, this is indefinite as more than one set of toolbar constraints that could be applied. For the remainder of the present prosecution, the examiner will interpret this statement as reading the destination toolbar constraints.

Double Patenting

9. Applicant is advised that should claims 15-18 be found allowable, claims 20-23 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 15-17 and 20-22 are child claims of claim 13. Claim 18 is a child claim of claim 17 and claim 23 is a child claim of 22. Claims 15-18 recite the same limitations as claims 20-23 and are substantial duplicates.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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11. Claims 13-23 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Claims 13-23 recite: "A computer program product, tangibly stored on a computer-readable medium, ..". While this is normally acceptable, applicant further adds from the specification (page 7 lines 1-7): "The invention can be implemented as a computer program product, i.e. a computer program tangibly embodied in an information carrier, e.g., in a machine-readable storage device or in a propagated signal, for execution..". Therefore, claims 13-23 must be given their broadest interpretation in view of the specification and are drawn to a computer program stored in a propagated signal. A propagated signal is not a series of steps or acts and this is not a process. A propagated signal is not a physical article or object and as such is not a machine or manufacture. A propagated signal is not a combination of substances and therefore not a compilation of matter. Thus, a propagated signal does not fall within any of the four categories of invention. Therefore, claims 13-23 are not statutory.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Microsoft Excel 2000 (Excel), copyright 1999 Microsoft Corporation, as evidenced by "Special Edition Using Microsoft Excel 2000", published by Que Corporation 1999 (Blattner et al.) and

“Special Edition Using Microsoft Office 2000”, published by Que Corporation 1999 (**Bott et al.**).

- **Claims 1 and 13: Excel** shows the method comprising:
 - receiving from a user of a graphical user interface an input requesting the moving of a button from a source toolbar to a destination toolbar (**Blattner et al.** pages 869-870 “Modifying Toolbars”, Fig. 28.13), the button having a button presentation and a set of button constraints (**Blattner et al.** page 871 Fig 28.16, pages 872-873 “Changing the Button Images”) and the destination toolbar having a toolbar presentation and a set of toolbar constraints (**Blattner et al.** pages 875-878 “Building Custom Toolbars”), the constraints being constraints on a presentation of the button or the destination toolbar, respectively;
 - calculating an adapted presentation of the destination toolbar with the button, including calculating a modified presentation of the button subject to set of button constraints and calculating a modified presentation of the destination toolbar subject to the set of toolbar constraints (**Blattner et al.** pages 875-878 “Building Custom Toolbars”); and
 - drawing the destination toolbar and the button on the destination toolbar according to the adapted presentation (**Blattner et al.** pages 875-878 “Building Custom Toolbars”).
- **Claim 2: Excel** shows the method of claim 1 above, wherein: the input further includes a request to move a control, the control having a control presentation and a

set of control constraints (Blattner et al. page 877 “Add buttons from the Commands tab in the Customize dialog box.”).

- Claims 3 and 14: Excel shows the method of claims 1 and 13, wherein: calculating the modified presentation of the button is further subject to the set of toolbar constraints; and calculating the modified presentation of the destination toolbar is further subject to the button constraints (Blattner et al. page 876-877).
- Claim 4, 15 and 20: Excel shows the method of claims 1 and 13, wherein: the destination toolbar includes a set of destination toolbar buttons at a time of the input; and the toolbar constraints comprise constraints specific to the destination toolbar and constraints derived from the set of destination toolbar buttons (Blattner et al. page 869 “Excel enables you to add and remove buttons on any of the default toolbars..”).
- Claims 5, 16 and 21: Excel shows the method of claims 1 and 13, wherein: the button presentation is defined by vector graphic data; and calculating a modified presentation of the button comprises calculating a size for the button, where the size is determined solely by the modified presentation of the destination toolbar (Blattner et al. page 872 “Copy an image from an image file.”).
- Claims 6, 17 and 22: Excel shows the method of claims 1 and 13, wherein: the button presentation is defined by raster graphic data and the button constraints specify that the button should be presented at one of a fixed number of presentation sizes (Blattner et al. page 872-873).

- Claims 7, 18, and 23: **Excel** the method of claims 6, 17 and 22, wherein: the fixed number of presentation sizes includes sizes of 24-by-24 pixels and 32-by-32 pixels (**Bott et al.** page 48 Fig. 2.9).
- Claims 8 and 19: **Excel** shows the method comprising:
 - receiving from a user of a graphical user interface an input requesting the docking of a source toolbar to a destination band, the destination band including a destination toolbar (**Blattner et al.** pages 869-870 “Modifying Toolbars”, Fig. 28.13 and **Bott et al.** pages 40-41 docking toolbars), the source toolbar having one or more source toolbar buttons (**Blattner et al.** pages 869-870 default toolbars, Fig. 28.13) , each of the one of more source toolbar buttons having a button presentation and a set of button constraints (**Blattner et al.** page 871 Fig 28.16, pages 872-873 “Changing the Button Images”), the source toolbar having a toolbar presentation and a set of toolbar constraints (**Blattner et al.** pages 875-878 “Building Custom Toolbars”), the destination toolbar having a toolbar presentation and a set of toolbar constraints (**Blattner et al.** pages 875-878 “Building Custom Toolbars”), the constraints being constraints on a presentation of the source toolbar buttons or source toolbar or the destination toolbar, respectively;
 - calculating an adapted presentation of the destination band with the one or more source toolbar buttons, including calculating a modified presentation of the one or more source toolbar buttons subject to the set of button constraints, calculating a modified presentation of the source toolbar and the destination

toolbar subject to the set of toolbar constraints (**Bott et al.** page 41 paragraph 1); and

- drawing the destination band, the destination toolbar and the one or more source toolbar buttons according to the adapted presentation (**Bott et al.** page 41 paragraph 1).

- **Claim 9: Excel** shows the method of claim 8, wherein: the destination toolbar includes a set of destination buttons at a time of the input; and the toolbar constraints comprise constraints specific to the destination toolbar and constraints derived from the set of destination buttons (**Blattner et al.** page 869 “Excel enables you to add and remove buttons on any of the default toolbars..”).
- **Claim 10: Excel** shows the method of claims 1 and 13, wherein: the button presentation is defined by vector graphic data; and calculating a modified presentation of the button comprises calculating a size for the button, where the size is determined solely by the modified presentation of the destination toolbar (**Blattner et al.** page 872 “Copy an image from an image file.”).
- **Claim 11: Excel** shows the method of claims 1 and 13, wherein: the button presentation is defined by raster graphic data and the button constraints specify that the button should be presented at one of a fixed number of presentation sizes (**Blattner et al.** page 872-873).
- **Claim 12: Excel** the method of claims 6, 17 and 22, wherein: the fixed number of presentation sizes includes sizes of 24-by-24 pixels and 32-by-32 pixels (**Bott et al.** page 48 Fig. 2.9).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent 6,111,576 (Moreland et al.) – pertains to the provision of menu functions as an attachment menu bar.
- U.S. Patent 5,644,737 (Tuniman et al.) – pertains to the stacking of a plurality of toolbars.
- U.S. Patent 5,644,739 (Moursund) – pertains to the adding of buttons to a toolbar.
- U.S. Patent 6,624,831 (Shahine et al.) – pertains to dynamically adjusting a toolbar to fit sizes based on an assigned set of priorities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Tank whose telephone number is 571-270-1692. The examiner can normally be reached on Mon - Fri (Alt. Fri Off) 0730-1500 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALT
March 29, 2007



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